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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,971	05/08/2001	Michael Tolson	507-000110US	4930
25555	7590	08/04/2004	EXAMINER	
JACKSON WALKER LLP 2435 NORTH CENTRAL EXPRESSWAY SUITE 600 RICHARDSON, TX 75080			HU, JINSONG	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/852,971	TOLSON ET AL.
	Examiner	Art Unit
	Jinsong Hu	2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 May 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/22/01, 2/22/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1-20 are presented for examination.
2. It is noted that although the present application does contain line numbers in the specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - A. The claim language in the following claims is not clearly understood.
 - i. As per claim 1, line 5, it is unclear whether "said graphical object" refers to "a graphical object" in line 2 [if they are the same, then such should use same name for consistency].
 - ii. As per claim 15, line 11, it is unclear whether "said graphic object" refers to "a portable information agent object" in line 2 [if they are the same, then such should use same name for consistency].

Correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 5-10, 12-15 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Pitroda (US 5,590,038).

6. Pitroda is a prior art reference cited by applicant on 1449 form, dated to 2/22/02.

7. As per claims 1, 10 and 14, Pitroda teaches the invention as claimed including a method of providing a portable information agent [col. 1, lines 9-14] comprising:

presenting a graphical representation [col. 3, lines 62-65] associated with said portable information agent in a composition accessed by an initial application, said portable information agent having state and having one or more possible external connections [Fig. 3; col. 3, line 65 – col. 4, line 11; col. 9, lines 54-63];

allowing relocation of said graphical object to a location outside of said initial application [col. 3, lines 34-43; col. 9, line 63 – col. 10, line 8];

and thereafter moving said portable information agent to said outside location, preserving state of said portable information agent [col. 3, lines 43-61; col. 4, lines 12-20; col. 11, lines 29-39].

8. As per claim 2, Pitroda teaches said portable information agent, once relocated, will persist and maintain state: after termination of said initial application [col. 3, lines 43-61; col. 4, lines 12-20; col. 11, lines 29-39].
9. As per claim 5, Pitroda teaches the initial application is a desktop provided by an operating system [col. 9, line 63 – col. 10, line 2].
10. As per claim 6, Pitroda teach said relocation may be repeated from a current location to any number of additional platforms [col. 2, line 48 – col. 3, line 3].
11. As per claims 7 and 8, Pitroda teaches said desktop provided by an operating system is an interface of a platform, said platform selected from the group consisting of a windows PC, a Macintosh PC, a Unix-type operating system, a set-top box, a wireless logic appliance, internet appliance, a personal digital assistant, or any other device connected to a network [24, Fig. 2].
12. As per claim 9, Pitroda teaches the portable information agent includes one or more user interface components and wherein said components are preserved after a relocation [Fig. 30].

13. As per claims 12 and 13, Pitroda teaches said allowing relocation comprises allowing a user to discontinuous select said graphical object and place said object in a new location [Fig. 9; col. 13, lines 25-26; col. 14, lines 9-22].

14. As per claim 15, Pitroda teaches the invention as claimed including a method of interacting with a portable information agent:

providing a portable information agent object in a composition accessed by an initial application [col. 2, lines 44-48];

allowing a user to select said portable information agent object and relocate said object outside of said initial application [col. 2, line 48 – col. 3, line 33];

upon detecting said relocating, determining if sufficient infrastructure logic exists to allow said object to operate in a new location, if said determining indicates that sufficient infrastructure does not exist, contacting an agent server to request necessary infrastructure logic, downloading and installing necessary infrastructure logic [col. 6, lines 16-43; col. 7, lines 11-31]; and

thereafter moving said graphic object to said new location [col. 7, lines 32-37].

15. As per claims 17 and 18, Pitroda teaches said new location is selected from the group consisting of: a desktop providing by an operating system; a different application: a different computer platform with a different operating system.

16. As per claims 19 and 20, Pitroda teaches said graphic agent object and said infrastructure allow communication with a data server for tracking user interaction after said object is moved to a new location desktop [col. 6, lines 17-43].

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. Claims 3-4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda (US 5,590,038) as applied to claims 1-2, 5-10, 12-15 and 17-20 above, in view of Slater (US 6,615,190).

19. As per claims 3-4 and 16, Pitroda teaches the invention substantially as claimed in claim 1. Pitroda does not specifically teach the initial application is a web page or an email client.

20. However, Slater on the other hand teaches the initial application is a web page or an email client [col. 3, lines 16-26]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Pitroda and Slater because utilizing Slater's web page and email in Pitroda's system would bring

convenience to user by allowing users selecting one communication method they preferred. One of ordinary skill in the art would have been motivated to modify the Pitroda's system with Slater's web page and email to attract more users.

21. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda (US 5,590,038) as applied to claims 1-2, 5-10, 12-15 and 17-20 above, in view of Drerup (US 5,740,364).

22. Drerup is a prior art reference cited by applicant on 1449 form, dated to 2/22/02.

23. As per claim 11, Pitroda teaches the invention substantially as claimed in claim 1. Pitroda does not specifically teach the step of allowing a user to select and drag said graphical object.

24. However, Drerup on the other hand teaches step of allowing a user to select and drag said graphical object [col. 1, line 65 – col. 2, line 5]. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Pitroda and Drerup because utilizing Drerup's step in Pitroda's system would increase the flexibility of the system by allowing the users rearrange the layout of the information. One of ordinary skill in the art would have been motivated to modify Pitroda's system to increase the flexibility of the system.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Wallerstein (US 5,955,961) discloses a transaction card;

Freeman et al. (US 6,450,407) discloses a chip card rebate system; and

Sehr (US 6,609,658) discloses a travel system.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (703) 306 – 5932.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee, can be reached on (703) 305-8498. The fax number for Group 2100 is (703) 872-9306.

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 305-3900.

Jinsong Hu

July 28, 2004


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100